UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,334	11/09/2001	Hidekazu Nakai	275788US6	5902

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ART UNIT	PAPER NUMBER
2153	

NOTIFICATION DATE	DELIVERY MODE
10/16/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/037,334	NAKAI, HIDEKAZU
	Examiner	Art Unit	
	Philip S. Scuderi	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _22 August 2007_.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1 and 3-12_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1 and 3-12_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All b) ☐ Some * c) ☐ None of:
   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____.
   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

I.   35 U.S.C. § 112

Applicant's arguments filed 31 July 2007 in regards to the §112 rejections have been fully

considered but they are not persuasive.

Applicant argues that claim 8 has been amended to comply with §112. This argument is not

deemed persuasive.

Claim 8 recites the limitation "means for controlling a download ..., and store the data."

The word "store" should presumably be replaced with the term "storage of" and has been

interpreted by the examiner accordingly. It is unclear whether (1) the means for controlling is also a

means for storage of the data; or (2) the claim requires a means for storage of the data that is

separate from the means for controlling.

II.   35 U.S.C. §§ 102-103

Applicant's arguments filed 31 July 2007 have been fully considered but they are not

persuasive.

Applicant argues that Hosoe (U.S. Patent No. 6,047,376) does not teach that at least part of

the data downloaded from the server includes a list of selectable content data based on a unique ID.

This argument is not deemed persuasive.

The specification does not define "a list of selectable content data." The examiner therefore

broadly interprets this limitation to mean two or more data items that are capable of being selected.

Hosoe teaches that the server identifies a service to provide to the client based on the

identification number [see fig. 7, col. 7, ll. 64 – col. 8, ll. 2]. The service is, for example, a music

information service that provides the client with artist, new music, and concert information [see col.

7, ll. 31-36].

Thus, Hosoe can be said to teach that at least part of the data (the music information)

downloaded from the server (38) includes a list of selectable content data (artist, new music, and

concert information capable of being selected) based on a unique ID (identification number) [see fig.

7, col. 7, ll. 31-36, col. 7, ll. 64 – col. 8, ll. 2].

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject
> matter which the applicant regards as his invention.

Claims 1, 3-5, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 1 recites the limitation "the data downloaded" in line 8, which lacks antecedent basis

in the claim. The "first storage region" recites "program information for ... downloading data"

(read: capable of downloading data), but does not actually limit the data to being downloaded.

Claim 8 recites the limitation "means for controlling a download ..., and store the data."

The word "store" should presumably be replaced with the term "storage of." It is unclear whether

(1) the means for controlling is also a means for storage of the data; or (2) the claim requires a

means for storage of the data that is separate from the means for controlling.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, 7, and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by

Hosoe (U.S. Patent No. 6,047,376).

As to claim 1, Hosoe teaches a recording medium, comprising:

a first storage region wherein program information (first program) describing a procedure

for executing a connection to a predetermined server (38) over a predetermined communication

network (100) and downloading data from the connected server (38), is stored [see fig. 2, col. 8, ll.

22-38 (first program is stored on the medium)];

a second storage region into which the data can be written (any writable storage region) [see

fig. 2, col. 4, ll. 49-65 (the memory medium can be writable, e.g., a floppy disk)]; and

a third storage region having an ID (identification number) unique to said recording medium

stored therein, wherein at least part of data from the server (38) includes a list of selectable content

data (music information comprising artist information, new music, and concert information) based

on the unique ID (identification number) [see fig. 2, 7].

As to claims 3-5, the ID (identification number) can be utilized by said server (38) to manage

accounting for the downloaded data, identify a type of the download data, or supply source of the

download data [see col. 6, ll. 41-49]. Note that to meet these claims the server only needs to be capable of utilizing the ID to manage accounting etc.

As to claim 7, Hosoe teaches a recording apparatus, comprising:

a readout unit configured to read out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server (38), the unique ID (identification number) is information which can be utilized by the server to manage accounting for the downloaded data [see fig. 2, col. 8, ll. 22-38 (first program is stored on the medium)];

a memory configured to be able to store data [see fig. 2, col. 4, ll. 49-65 (the memory medium can be writable)];

a display device (display device 23) configured to display (capable of displaying) a list of selectable content data (music information comprising artist information, new music, and concert information) transmitted from the server (38) and based on the unique ID (identification number) [see fig. 1, 7, col. 5, ll. 1-10]; and

a controller configured to control (capable of controlling) downloading required from the server (38) in accordance with the read out program information (first program), and store the data acquired by the downloading with identification information indicating a relationship to the program information into the memory [see fig. 2].

As to claim 10, Hosoe teaches a playback apparatus comprising:

a readout unit configured to read out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined

server (38) and downloading data from the server (38), the unique ID (identification number) is information which can be utilized by the server (38) to manage accounting for the downloaded data [see fig. 2].

a memory configured to store content data with identification information indication a relationship to the program information [see fig. 2, col. 4, ll. 49-65 (the memory medium can be writable)];

a display device (display device 23) configured to display (capable of displaying) a list of selectable content data (music information comprising artist information, new music, and concert information) transmitted from the server (38) and based on the unique ID (identification number) [see fig. 1, 7, col. 5, ll. 1-10]; and

a controller configured to playback the content data based on the read out program information [see fig. 2].

As to claim 11, Hosoe teaches a playback apparatus comprising:

means for reading out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server, the unique ID (identification number) is information which can be utilized by the server (38) to manage accounting for the downloaded data [see fig. 2, col. 8, ll. 22-38 (first program is stored on the medium)];

means for storing content data (e.g., music) with identification information (identification number) indicating a relationship to the program information (stored on the same media) [see fig. 2]; and

means for displaying (display device 23) a list of selectable content data (music information comprising artist information, new music, and concert information) transmitted from the server (38) and based on the unique ID (identification number) [see fig. 1, 7, col. 5, ll. 1-10]; and

means for playback of the content data (e.g., music) based on the read out program information (e.g., based on information obtained from a music information service using the first program) [see fig. 2, col. 7, ll. 29-54].

As to claim 12, Hosoe teaches a playback method for a playback apparatus having a memory comprising:

a readout step of reading out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server (38), the unique ID (identification number) is information which can be utilized by the server to manage accounting for the downloaded data [see fig. 2];

a playback step of playback content data (e.g., music) with identification information (identification number) indicating a relationship to (stored on the same media) the program information (first program) from the memory based on the read out program information (e.g., based on information obtained from a music information service using the first program) [see fig. 2, col. 7, ll. 29-54];

an acquiring step of acquiring a list of selectable content data (music information comprising artist information, new music, and concert information) based on the unique ID (identification number) [see fig. 7, col. 7, ll. 28-54]; and

a transferring step of transferring the list of content data (music information comprising

artist information, new music, and concert information) [see fig. 7, col. 7, ll. 28-54].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hosoe (U.S. Patent No. 6,047,376).

As to claim 6, Hosoe teaches a downloading method, comprising:

a readout step of reading out program information (first program), from a recording medium

(35) having a first storage region wherein the program information (first program) describes a

procedure for executing a process for establishing a connection to a predetermined server (38) over

a predetermined communication network (the WWW) and downloading data (music information

comprising artist information, new music, and concert information) from the connected server (38)

is stored, a second storage region into which the data can be written (any writable region capable of

storing the music information), and a third storage region having an ID unique (identification

number) to said recording medium stored therein [see fig. 2, col. 7, ll. 28-54, col. 8, ll. 22-38 (first

program is stored on the medium)];

an access step of accessing said server (38) in accordance with the read out program

information (first program) [see col. 8, ll. 22-38];

an acquiring step of acquiring a list of selectable content data (music information comprising artist information, new music, and concert information) based on the medium ID (identification number) [see fig. 7, col. 7, ll. 28-54];

a transferring step of transferring the list of content data (music information comprising artist information, new music, and concert information) [see fig. 7, col. 7, ll. 28-54]; and

a download step of downloading required data (music information comprising artist information, new music, and concert information) from said server (38) accessed in accordance with the read out program information (first program) [see fig. 7, col. 7, ll. 28-54].

Hosoe does not expressly disclose storing the data acquired by the downloading into the second storage area of the storage medium. Hosoe discloses that the medium can be a writable medium such as a floppy disk [see col. 4, ll. 49-65]. It would have been obvious to one of ordinary skill in the art to store the data acquired by the download on the medium because the data acquired is data that is desired by the user of the medium [see col. 7, ll. 36-39].

As to claim 8, Hosoe teaches a recording apparatus, comprising:

means for reading out program information (first program) and a unique ID (identification number) from a recording medium (35), wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data (music information comprising artist information, new music, and concert information) from the server (38), the unique ID (identification number) is information which can be (is capable of being) utilized by the server (38) to manage accounting for the downloaded data (music information comprising artist information, new music, and concert information) [see fig. 2, col. 7, ll. 28-54, col. 8, ll. 22-38 (first program is stored on the medium)];

means for storing data [see col. 4, ll. 49-65 (the medium can be writable, e.g., a floppy disk)];

means for displaying (display device 23 and/or CPU 11) a list of selectable content data

(music information comprising artist information, new music, and concert information) transmitted

from the server and based on the unique ID (identification number) [see fig. 1, 7, col. 5, ll. 1-10]; and

means for controlling a download of required data from the server (38) in accordance with

the read out program information (first program) [see fig. 2].

Hosoe does not expressly disclose storing the data acquired by the downloading into the

second storage area of the storage medium. Hosoe discloses that the medium can be a writable

medium such as a floppy disk [see col. 4, ll. 49-65]. It would have been obvious to one of ordinary

skill in the art to store the data acquired by the download on the medium because the data acquired

is data that is desired by the user of the medium [see col. 7, ll. 36-39].

As to claim 9, Hosoe teaches a recording method for a recording apparatus having a

memory, comprising:

a readout step of reading out program information (first program) and a unique ID

(identification number) from a recording medium (35), wherein the program information (first

program) describes a procedure for executing a process for establishing a connection to a

predetermined server (38) and downloading data (music information comprising artist information,

new music, and concert information) from the server (38), the unique ID (identification number) is

information which can be utilized by the server (38) to manage accounting for the downloaded data

(music information comprising artist information, new music, and concert information) [see fig. 2,

col. 7, ll. 28-54, col. 8, ll. 22-38 (first program is stored on the medium)]; and

a downloading step of downloading required data (music information) from the server (38)

in accordance with the read out program information (first program) [see fig. 2, col. 7, ll. 28-54, col.

8, ll. 22-38]; and

wherein at least a part of data (music information comprising artist information, new music, and concert information) provided by the server (38) includes a list of selectable content data (music information comprising artist information, new music, and concert information) based on the unique ID (identification number) [see fig. 2, col. 7, ll. 28-54, col. 8, ll. 22-38].

Hosoe does not expressly disclose storing the data acquired by the downloading into the second storage area of the storage medium. Hosoe discloses that the medium can be a writable medium such as a floppy disk [see col. 4, ll. 49-65]. It would have been obvious to one of ordinary skill in the art to store the data acquired by the download on the medium because the data acquired is data that is desired by the user of the medium [see col. 7, ll. 36-39].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
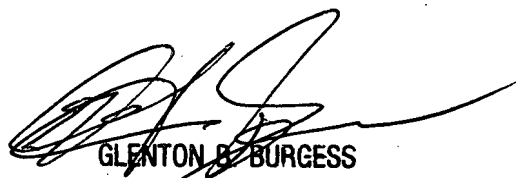
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Philip S. Scuderi/

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